

REMARKS

Claims 22 – 37, 55 and 59 - 83 are pending.

The rejections are addressed below in detail. No new matter is introduced in this amendment. In summary:

- 1) Claims 1 - 23, 31- 35 were previously withdrawn;
- 2) the §112 rejection is addressed again below to resolve the Examiner's remaining rejection;
- 3) the remaining rejection of the claims under §103 is addressed below through traverse and argument.

Paragraph 4-5: Rejection of claims 22, 24, 25, 27, 35 and 37

The rejection under §112 is traversed again based on the prior amendment discussion, incorporated by reference herein, and the following submission. Here is the language again:

- ...(a) first computer coupled to the network...
- (b) a second computer coupled to the network; and
- (c) a first software routine executing on said first computer **and/or** said second computer....

The claim clearly sets out a “first” computer (limitation (a)) and a “second” computer (limitation (b)). It then sets out a “first software routine” (limitation (c)) which executes on either or both of the first computer and second computer. That is the commonly understood meaning of such phrase under any logical parsing of the words.

The Examiner states that he is unclear on what is meant in claim 22, but does not provide any argument on why the above proffered interpretation is unreasonable or unsupported by the specification. The test for compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity *when read in light of the application disclosure* as they would be interpreted by one of ordinary skill in the art. In re Moore, 439 F.2d 1232, 1235 (CCPA 1971). The specification here in fact documents this exact interpretation, namely that the routine can be implemented in both locations (i.e., in some distributed capacity) or in one of (either A, B) the locations. See page 5, ll. 30 – 32, and page 21, ll. 10 – 11:

“...For ease of use, the setup and transfer may be performed by either or both of such devices.”

Under the circumstances Applicant submits that the rejection is not appropriate based on the applicable legal standard. Moreover, a basic search of the US database reveals *no less than 1450 separate patents* issued in class 705 alone with similar “and/or” language in the claims. This is well understood terminology in this field.

Applicant further notes that, as recently as a few months ago, a patent on which the *present* Examiner was of record – namely US Patent No. US7636847 - issued with similar “and/or” language in the claims. For these reasons, and others previously listed, Applicant submits that there is nothing indefinite about this language as it is commonly used in this field of art, and the useage in the claim is rather ordinary as demonstrated by the Examiner’s own experience.

Paragraphs 6 – 7 - Rejection of claims 22 - 37 and 55, 59 - 80 under § 103

These claims are rejected now under § 103 based on the Levy reference, US Publication No. 2002/0052885, taken now with Williams - Publication No. 2002/0002541. Initially Applicant notes that the Examiner’s response does not apparently take into account several limitations of the claims. Paragraph 7 on page 3 lists arguments for limitations identified as “A” through “D” but there is absolutely no discussion or citation on where the prior art teaches any of the following limitations of claim 22:¹

wherein a second instantiation of said digital asset is created for said transfer to said second computer, said second instantiation including a second unique identifier including customer information associated with a customer for said digital asset;

further wherein said digital asset has no copy protection and can be transferred from said second computer to a third computer by said customer without requiring an additional authorization from said first computer.

As noted in MPEP 706, “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to

¹ As a preliminary matter therefore, Applicant notes that any subsequent Office Action cannot be made final since there has been no discussion of these elements of the claims on the record. Clarification of the Examiner’s position on these elements is necessary to establish a complete record.

provide evidence of patentability and otherwise reply completely at the earliest opportunity.” Furthermore 37 C.F.R. 1.104(C)(2) requires an examiner to cite to specific portions of a reference. This has not been done here.

As noted in a recent BPAI decision:

We agree with the Appellants that the Examiner does not appear to have addressed these claims. We have reviewed the Record but have been unable to determine how and why the Examiner has determined these claims are obvious over Hawkins and Sandhu. **Accordingly, the rejection of these claims will be reversed.** See e.g. Appeal 2009-013300 (April 23, 2010)

This is consistent with known precedent that it is improper to fail to consider any limitation of the claims. In re Geerdes, 491 F.2d 1260, 1262, 180 USPQ 789 (CCPA 1974) (“...every limitation in the claim must be given effect rather than considering one in isolation from the others”). The record is equally incomplete here since the Examiner has not addressed these limitations of claim 22, and on its face therefore the current rejection would not be sustained.

In any event the Applicant submits that this is a moot point anyway since the reference does not disclose these limitations. More importantly the Examiner’s citation to Williams (US Publication No. 20020002541) to address deficiencies in Levy is unavailing for the simple reason that the latter does not in fact teach the limitation in question. That is, the Examiner states:

as music) and to various methods for distributing digital content. According to Williams, the content is encrypted using a unique identifier that is associated with user’s computer, date that the users’ root file system was created, MAC address, or the like (par. 47). Therefore, it would have been obvious for one of ordinary skill in the art at the time of applicant’s invention to construct a unique identifier as described in Williams to modify Levy’s invention. According to Williams, the motivation to use such a unique identifier would be to prevent reverse engineering of the identifier, which could allow for unauthorized duplication of content received.

The Examiner indicates that William’s unique identifier would prevent reverse engineering of the identifier, and thus by implication prevent unauthorized duplication of content received. The problem with this logic is that William’s identifier, as the Examiner acknowledges, is a form of copy protection; that is, it is used directly as a key

to encrypt the content to prevent copying. This is in direct contravention to the claim language which states:

....further wherein said digital asset has no copy protection

Applicant submits that there is no possible interpretation of this limitation (let alone a “reasonable” interpretation”) that could be met by a system like Levy/Williams which in fact is using a form of copy protection as the Examiner notes. Williams further emphasizes this aspect of its operation:

....distribution module 316 (or another appropriate module) suitably encrypts the content to prevent unauthorized copying/redistribution...” See paragraph 47.

Accordingly Williams cannot possibly meet this limitation of the claim.

This aspect of the invention, which focuses on simply tracking transfers, and not introducing cumbersome copy prevention schemes, is discussed at length in the disclosure including at page 21, ll. 21 – 26. The focus of Levy and Williams, like most prior art, is to prevent unauthorized copying using cumbersome DRM procedures. From an obviousness perspective, there could not be a clearer example of teaching away.

Accordingly Applicant requests reconsideration of the rejection on this basis.

Dependent claims 23 - 37 should be allowable for at least the same reasons.

Independent claim 55 should be allowable for similar reasons. Dependent claims 59 - 74 should be allowable for at least the same reasons.

Independent claim 75 is allowable for similar reasons. Moreover the Applicant amended the claim to indicate that the digital asset carries a complete transaction record of transfers of prior versions. The Examiner makes no mention anywhere of where such limitation is found anywhere in any of the prior art, and thus has not established a prima facie case against this claim. Applicant finds no such mention either.

Dependent claims 76 – 80 should be allowable for at least the same reasons.

As noted before, Levy does not teach “determining a source of a prior transfer” of an unauthorized version. At best it can apparently only identify the existence of an unauthorized copy.

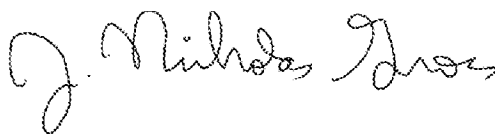
New claims 81 – 83 are dependent on claim 22 and merely describe narrower embodiments of the invention identified on pages 22 (ll. 14+ and 29 - 30) and page 29 (ll. 20 – 24)(time stamps); page 28 line 20 (advertisements).

Conclusion

The rejections and objections from the Examiner have been addressed in detail as noted above. For the reasons set forth above, the undersigned submits that the claims should be confirmed as patentable over the references.

A petition and fee for a 1 month extension of time is also provided. Please debit any fees from account no. 501-244. Should the Examiner wish to discuss the present case at any time, please contact the undersigned at any convenient opportunity.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "J. Nicholas Gross".

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